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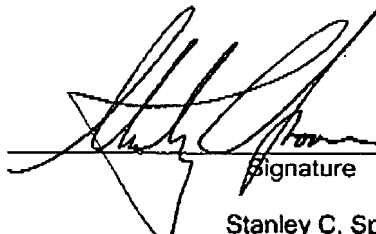
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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SCS-550-229
	Application Number 09/854,491	Filed May 15, 2001
	First Named Inventor HOULIHANE	
	Art Unit 2123	Examiner J. Proctor
	<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>	
<div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p>I am the</p> <p><input type="checkbox"/> Applicant/Inventor</p> <p><input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> Attorney or agent of record <u>27,393</u> (Reg. No.)</p> <p><input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____</p> </div> <div style="width: 50%; text-align: center;">  Signature Stanley C. Spooner <hr/> Typed or printed name <hr/> 703-816-4028 Requester's telephone number <hr/> September 24, 2007 Date </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of 1 form/s are submitted.</p>		

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**STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the Final Official Action mailed May 22, 2007 (Paper No. 20070515).

**Error #1. The Examiner errs in concluding that the
claim 1 limitation to "non cycle-based sampling rules"
is not supported in the present specification**

In the Final Rejection, page 2, section 1, the Examiner attempts to respond to the deficiencies in his arguments previously noted by Applicants by alleging that one argued limitation "non cycle-based sampling rules" is not supported in the specification. First and foremost, Applicants note that the Examiner has not rejected any of the pending claims under 35 USC §112 as being indefinite.

Moreover, the Examiner ignores Applicants' specification, page 4, lines 12-17, which compares the "simple cycle based approach" to sampling systems to the claimed "reduced model" and its non-cycle based approach which is "more flexible and more compact." The specification states "the reduced model does not force any artificial timing restrictions due to cycle based sampling approaches [i.e., a "non cycle-based sampling" approach] and tends not to generate the impractically large file sizes that can be associated with cycle based approaches."

The Examiner's attention is also directed to the sentence bridging pages 7 and 8 of the Applicants' specification. The Examiner essentially concedes that this cited portion of the specification provides almost *in haec verba* basis for the above amendment to claim 1. While the Examiner alleges on page 3 of the Official Action that the specification does not contain any disclosure that there is a dependence upon recorded signals, his attention is directed to the

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specification on page 7 which states "the list of signals 18 produced by step 16 is then used at step 20 to generate models that can serve to replay the recorded input signals within the POC file in response to data drawn from the POC file 10."

Thus, there is no doubt that, at least with respect to those having ordinary skill in the art to which the presently claimed invention is directed, Applicants' specification as originally filed clearly supports the "non-cycle-based" approach set out in the claims.

Error #2. The Examiner continues to admit that the claim 1 limitation is not present in Gupte but fails to point out where it is disclosed in Holstine

On page 11 of the Final Rejection and page 5 of the previous Official Action, the Examiner admits that "Gupte does not expressly teach recording input signals to and output signals from said subsystem circuit in response to changes in at least one of said input signals and said output signals." This repeated admission is very much appreciated.

The Examiner now alleges that the missing "recording" step is disclosed on page 2, the 1st paragraph and on page 4, the 6th paragraph of Holstine. Those of ordinary skill in the art will clearly understand that "to make VHDL simulation vector analysis EDA-vendor-independent across multiple simulators," Holstine uses a VHDL standard TEXTIO package to write simulation output to a text file in a print-on-change format. Specifically, the paragraph states "all of the primary ports of a design are input to the monitor, and their values are printed to a text file whenever the value of any port changes."

Moreover, Holstine has no disclosure of the claimed method step of "generating . . . a plurality of non cycle-based sampling rules" An examination of Holstine's page 7, paragraph 6, shows it is related to "generating and verifying test vectors" which relate to

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analyzing required vector sets for conformance with tester rules (“to check whether the vector sets will operate on our tester, we developed two tools . . .”).

Thus, the Examiner’s allegation that Holstine “clearly teaches either the “recording” step or the testing the operation of a data processing apparatus by the claimed method of “generating . . . a plurality of non cycle-based sampling rules” is simply incorrect and is not supported by the cited portions of the Holstine reference.

Error #3. The Examiner again fails to disclose where Holstine or Gupte teach the claim limitations of the “recording” step

Applicants’ method claim 1 recites a recording step “in response to changes in at least one of said input signals and said output signals whilst performing said test sequence of data processing operations.” The Examiner continues to misstate the recording step and omits the language “in response to changes in at least one of said input signals and said output signals.” Thus, the Examiner suggests that the “recording” step is accomplished but does not allege that it is performed “in response to changes in at least one of said input and said output signals whilst performing said test sequence of data processing operations.”

The Examiner’s continued misstatement of the language of Applicants’ claim 1 is believed to be an admission that neither Gupte nor Holstine disclose the subject matter of the claimed “recording” step.

Error #4. The Examiner correctly identifies Gupte as teaching a simple cycle-based approach and apparently fails to appreciate that Applicants’ claim relates to a “non cycle-based” approach

In Applicants’ previously filed Amendment on page 20, it was pointed out that the Gupte reference teaches a system in which golden vectors are captured during system simulation and

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outputs are generated by an ASIC during stand-alone simulation and are compared to the golden vectors to test for correct operation of that ASIC (see Gupte column 2, lines 6-22). Thus, Gupte discloses a simple cycle-based approach in which test vectors are replayed and responses recorded as is well known.

As discussed in Applicants' specification at page 4, lines 12-13, such cycle-based approaches are well known. Thus, the Examiner's statement on page 6, lines 2 and 3 of the Final Rejection are absolutely correct, i.e., the specification does disclose "a simple cycle-based approach" but this is the known prior art. However, as noted above, Applicants' claims (rather than the prior art discussed in the specification and disclosed in Gupte) relates to a "non cycle-based" approach which provides a number of benefits disclosed in Applicants' specification.

The Examiner avoids any discussion of where the "non cycle-based" sampling is disclosed in the Holstine or Gupte references and therefore there is no support for any further rejection under §102.

Error #5. The Examiner identifies no "reason" or "motivation" for combining the Gupte and Holstine references

The Examiner again repeats verbatim that "Holstine and Gupte are analogous art because both are drawn to circuit simulation." Whether or not they are considered "analogous art," the burden is on the Examiner to provide some reason or motivation for combining these references. In view of the recent Supreme Court decision in *KSR*, Deputy Commissioner for Patent Operations, Margaret A. Focarino, in her May 3, 2007 Memo, held that "in formulating a rejection under 35 USC §103(a) based upon a combination of prior art elements, it remains necessary [for the examiner] to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." The Examiner has simply

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identified no reason why one of ordinary skill in the art would pick and choose method steps from the Holstine and Gupte references and then combine them in the manner of Applicants' method claim 1 and apparatus claim 17. Thus, even if the claimed method steps and apparatus elements were disclosed in these references (and this contention is respectfully traversed), there is no reason to combine these references and therefore any further rejection necessarily fails for the lack of any *prima facie* basis.

SUMMARY

In view of Applicants' previous Amendment, claim 1 clearly requires the generation of "a plurality of non cycle-based sampling rules." The Examiner admits that this is not disclosed in the Gupte reference and his citation to Holstine for the missing teaching simply fails to contain any aspect of the claimed requirement. The Examiner attempts to get around this positive claim requirement by arguing that it is now somehow missing from Applicants' specification. The above shows that it is clearly included in the specification and, in any event, there is no pending rejection of the claims as being unsupported by the specification. As a result, even if the references were combined, they do not teach or render obvious the claimed invention. Moreover, the Examiner has failed to provide any motivation for combining portions of these two references in the manner of Applicants' independent claims. As a result, the Examiner has simply failed to establish any *prima facie* case of obviousness under 35 USC §103.

As a result of the above, there is simply no support for the rejection of Applicants' independent claims or claims dependent thereon under 35 USC §103. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.